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In re Application of :
GREMLEY, Sarah :
Application No.: 10/521,139 : DECISION ON PETITION
Filing Date: 12 January 2005 : UNDER 37 CFR 1.137(b)
Attorney Docket No.: 006329.00005 :
For: PICTURE FRAME :
: :
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This is a decision on applicant's "Petition to Revive an Unintentionally Abandoned Application under 37 CFR 1.137(b)" filed 12 January 2005 in the above-captioned application.

BACKGROUND

On 23 May 2003, applicant filed international application PCT/GB03/02228 which claimed a priority date of 23 May 2002. Pursuant to 37 CFR 1.495, the deadline for payment of the basic national fee was to expire 30 months from the priority date, or at midnight on 23 November 2004.

On 12 January 2005, applicant filed, *inter alia*: a transmittal letter to the US Designated/Elected Office Concerning a Filing under 35 U.S.C. 371; an application containing a specification, including claims and drawings; a Fee transmittal for FY 2005; copy of the international application; a preliminary amendment for continuation of PCT/GB03/02228; an application data sheet; and the instant petition and fee to revive the international application as to the United States under 37 CFR 1.137(b).

DISCUSSION

International application PCT/GB03/02228 became abandoned as to the United States of America at midnight on 23 November 2004 for failure to pay the basic national fee.

A. Conflict In Filing Instructions

Any intended filing of an international application as a national stage application must clearly and unambiguously be identified as such and must satisfy all of the conditions set forth in 35 U.S.C. 371(c). See 37 CFR 1.495(g):

The documents and fees submitted . . . must be clearly identified as a submission to enter the national stage under 35 U.S.C. 371, otherwise the submission will be considered as being made under 35 U.S.C. 111.

In addition, section 1893.03(a) of the MPEP states that:

If there are any conflicting instructions as to whether the filing is under 35 U.S.C. 111(a) or 35 U.S.C. 371, the application will be accepted as filed under 35 U.S.C. 111(a).

On 12 January 2005, applicant submitted a preliminary amendment which indicates this application is a "continuation of PCT/GB03/02228." Additionally, the instant petition to revive the international application as to the United States under 37 CFR 1.137(b) indicated that this application is a continuation of PCT/GB03/02228. The above indications are inconsistent with an intent to enter the national stage of the PCT under 35 U.S.C. 371. Accordingly, the original papers deposited on 12 January 2005 will be treated as a filing under 35 U.S.C. 111(a).

B. Petition under 37 CFR 1.137(b)

A petition under 37 CFR 1.137(b) requesting that PCT/GB03/02228 be revived as to the United States on the grounds of unintentional abandonment must be accompanied by (1) the required reply, (2) the petition fee required by law, (3) a statement that the "entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition was unintentional," and (4) any terminal disclaimer and fee required pursuant to 37 CFR 1.137(c). Items (2) and (4) have been satisfied.

Item (1) has not been met. The proper reply is either: a) the filing of the continuing application under 35 U.S.C. 111(a) or b) a proper national stage submission under 35 U.S.C. 371 including the payment of the basic national fee. While applicant has provided instructions that the instant application is to be treated as a continuation application of PCT/GB03/02228, applicant has not provided a benefit claim to the PCT application in accordance with 37 CFR 1.78(a)(2) and therefore is not entitled to benefit of the PCT application under 35 U.S.C. 365(c) and 120. Moreover, for reasons explained above, the reply was not a proper 35 U.S.C. 371 submission.

Item (3) has not been met. A review of the petition reveals that there is a question as to whether the delay was unintentional. The Manual of Patent Examining Procedure, Section 711.03(c), states that "a delay resulting from a deliberately chosen course of action of the part of the applicant does not become an 'unintentional' delay within the meaning of

37 CFR 1.137(b) because the applicant remains interested in eventually obtaining a patent, but simply seeks to defer patent fees and patent prosecution expenses." Petitioner states that "[t]he applicants failed to respond with timely instructions to the Barker Brettell firm due to misunderstandings regarding PCT practice on the part of the Applicants. More specifically, the Applicants reason for not providing instruction earlier to Barker Brettell to initiate the U.S. national phase was a combination of a temporary lack of funds and a mistaken belief that the U.S. national phase could be entered later." Petitioner's statements suggest that the applicants may have simply been seeking to defer patent fees and prosecution expenses. Applicants are required to provide further information in this regard, including production of Baker Bretell's instruction regarding initiating the national phase application, which presumably, would have warned of abandonment.

CONCLUSION

The petition under 37 CFR 1.137(b) is **DISMISSED** without prejudice and international application no. PCT/GB03/02228 remains **ABANDONED**.

If reconsideration on the merits of this petition is desired, a proper response must be filed within **TWO (2) MONTH** from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.137(b)." No additional petition fee is required.

Any further correspondence with respect to this matter should be addressed to:
Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



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